

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

09/002,276

12/31/97

CRIM

S

97-500

LM02/0203

JOHN A ODOZYNSKI GTE SERVICE CORPORATION 600 HIDDEN RIDGE HQE03G05 IRVING TX 75038-3809 MCCARTY, W

ART UNIT PAPER NUMBER

2761

DATE MAILED:

02/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/002,276

Examiner

Applicant

McCarty

Group Art Unit 2761

Crim et al.



X Responsive to communication(s) filed on Oct 1, 1998	
☐ This action is FINAL.	
☐ Since this application is in condition for allowance except for formal matters, in accordance with the practice under Ex parte Quayye35 C.D. 11; 453 O.G. 2	
A shortened statutory period for response to this action is set to expire3month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).	
Disposition of Claim	
	is/are pending in the applicat
Of the above, claim(s)	is/are withdrawn from consideration
∑ Claim(s) 13-16, 28-31, and 43-48	is/are allowed.
X Claim(s) <u>1-12, 17-27, and 32-42</u>	is/are rejected.
Claim(s)	is/are objected to.
Claims are	e subject to restriction or election requirement.
Application Papers See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on	
☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §	3 119(e).
Attachment(s) Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152	·
SEE OFFICE ACTION ON THE FOLLOWING PAGES	

Art Unit: 2761

DETAILED ACTION

This first Office Action is responsive to application **09/002,276** filed December 31, 1997.

Claims 1-48 are presented for examination on their merits.

Allowable Subject Matter

1. The following is a statement of reasons for the indication of allowable subject matter: claims 13-14, 28-29, 43-44, and 47 appear to contain allowable subject matter because the prior art of record fails to disclose a method for billing customers for requested products comprising the steps, performed by a processor, of: determining whether codes identify a selected bundle of products from at least two providers; computing any discount based on the result of the determination; computing taxes for each of the products; and generating a bill including the usage data in the specified format, and reflecting the computed discount and taxes; a billing controller for billing customers for requested products comprising: a component configured to determine whether codes identify a selected bundle of products from at least two providers; means for computing any discount based on the result of the determination, and the taxes for each of the products; and a generator configured to generate a bill including the usage data in the specified format, and reflecting the computed discount and taxes; a computer program product comprising a computer usable medium having computable readable code embodied

Art Unit: 2761

therein for billing customers for requested products, the computer usable medium comprising: a module configured to determine whether codes identify a selected bundle of products from at least two providers; a computing module configured to compute any discount based on the result of the determination and taxes for each of the products; and a generating module configured to generate a bill including the usage data in the specified format, and reflecting the computed discount and taxes; and a data processing system for billing customers for requested products, comprising: a central controller, connected to the usage gateway controller, configured to determine whether codes identify a selected bundle of products from at least two providers; compute any discount based on the result of the determination; compute taxes for each of the products; and generate a bill including the usage data in the specified format and reflecting the computed discount and taxes.

Dependent claims 15-16, 30-31, 45-46, and 48 appear allowable for being dependent upon an allowable base claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

⁽e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Page 4

Application/Control Number: 09/002,276

Art Unit: 2761

3. Claims 1, 17, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,909,492 to *Payne et al.*

As to claim 1, Payne discloses a method for processing requests for products (request for purchasing a product; col.1, lines 57-58) comprising the steps, performed by a processor, of:

receiving a request identifying a customer and indicating one of a plurality of providers for a selected product (request transmitted to merchant computer wherein the user, i.e. customer, is identified through the access message authenticator and further wherein indication of one of a plurality of providers is made through selection of one of the plurality of products, digital advertisements of which are transmitted to the user; col.1, line 51 - col.3, line 56);

converting a portion of the received request into a provisioning request based on the selected product (access message; col.1, line 62+); and

providing the provisioning request to the provider (sending access message, which contains request therein, to merchant computer; col.1, lines 64-65).

As to claim 17, Payne discloses a billing controller for processing requests for products (payment computer [16]; col.1, line 54+; col.5, line 5+) comprising:

a receiver configured to receive a request identifying a customer and indicating one of a plurality of providers for a selected product (request transmitted to merchant computer wherein the user, i.e. customer, is identified through the access message authenticator and further wherein indication of one of a plurality of providers is made through selection of one of the plurality of

Art Unit: 2761

products, digital advertisements of which are transmitted to the user; col.1, line 51 - col.3, line 56);

a converter configured to convert a portion of the received request into a provisioning request based on the selected product (access message; col.1, line 62+); and

a component configured to provide the provisioning request to the provider (sending access message, which contains request therein, to merchant computer; col.1, lines 64-65).

As to claim 32, Payne discloses a computer program product comprising a computer usable medium having computable readable code embodied therein for processing requests for products (computer network based sales system; col.1, lines 51-52), the computer usable medium comprising:

a receiving module configured to receive a request identifying a customer and indicating one of a plurality of providers for a selected product (request transmitted to merchant computer wherein the user, i.e. customer, is identified through the access message authenticator and further wherein indication of one of a plurality of providers is made through selection of one of the plurality of products, digital advertisements of which are transmitted to the user; col.1, line 51 - col.3, line 56);

a converting module configured to convert a portion of the received request into a provisioning request based on the selected product (access message; col.1, line 62+); and

Art Unit: 2761

a provisioning module configured to provide the provisioning request to the provider (sending access message, which contains request therein, to merchant computer; col.1, lines 64-65).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 17-21, and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,799,156 to *Shavit et al.*

As to claim 1, Shavit discloses a method for processing requests for products (processing of business transactions; col.1, lines 1-12) comprising the steps, performed by a processor, of:

receiving a request identifying a customer and indicating one of a plurality of providers for a selected product (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60; multiple sources available to shop for goods; col.6, lines 39-41);

Application/Control Number: 09/002,276

Art Unit: 2761

converting a portion of the received request into a provisioning request based on the selected product (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and

Page 7

providing the provisioning request to the provider (transmitting order to distributor via authorization inquiry; col.14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 2, Shavit discloses the method of claim 1, wherein the converting step includes the substeps of accessing a format database for stored format information of the provider; and using the format information to convert the portion of the received request into the provisioning request (proprietary format; col.15, lines 33-35; translate content of transactions; col.15, lines 7-11).

As to claim 3, Shavit discloses the method of claim 1, wherein the step of providing the provisioning request to the provider includes the substep of storing information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

Art Unit: 2761

As to claim 4, Shavit discloses the method of claim 1, wherein the step of providing the provisioning request to the provider includes the substep of determining a means for providing the provisioning request to the provider (choice available between on-line and manual transaction; col.15, lines 45-60).

As to claim 5, Shavit discloses the method of claim 1, wherein the step of providing the provisioning request to the provider includes the substep of electronically transmitting the provisioning request to the provider (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 6, Shavit discloses the method of claim 1, wherein the step of providing the provisioning request to the provider includes the substep of physically delivering the provisioning request to the provider (manual intercept; col.15, lines 48-51).

As to claim 17, Shavit discloses a billing controller for processing requests for products (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48) comprising:

a receiver configured to receive a request identifying a customer and indicating one of a plurality of providers for a selected product (user profile is extracted from the data base upon

Art Unit: 2761

initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60; multiple sources available to shop for goods; col.6, lines 39-41);

a converter configured to convert a portion of the received request into a provisioning request based on the selected product ((converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and

a component configured to provide the provisioning request to the provider (transmitting order to distributor via authorization inquiry; col.14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 18, Shavit discloses the billing controller of claim 17, wherein the converter includes a component configured to access a format database for stored format information of the provider and use the format information to convert the portion of the received request into the provisioning request (proprietary format; col.15, lines 33-35; translate content of transactions; col.15, lines 7-11).

As to claim 19, Shavit discloses the billing controller of claim 17, wherein the component configured to provide the provisioning request to the provider includes storage configured to store information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

Art Unit: 2761

As to claim 20, Shavit discloses the billing controller of claim 17, wherein the component configured to provide the provisioning request to the provider includes means for determining a means for providing the provisioning request to the provider (choice available between on-line and manual transaction; col.15, lines 45-60).

As to claim 21, Shavit discloses the billing controller of claim 17, wherein the component configured to provide the provisioning request to the provider includes a transmitter configured to electronically transmit the provisioning request to the provider (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 32, Shavit discloses a computer program product comprising a computer usable medium having computable readable code embodied therein for processing requests for products (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48), the computer usable medium comprising:

a receiving module configured to receive a request identifying a customer and indicating one of a plurality of providers for a selected product (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60; multiple sources available to shop for goods; col.6, lines 39-41);

Art Unit: 2761

a converting module configured to convert a portion of the received request into a provisioning request based on the selected product ((converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and

a provisioning module configured to provide the provisioning request to the provider (transmitting order to distributor via authorization inquiry; col.14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 33, Shavit discloses the computer program product of claim 32, wherein the converting module includes a module configured to access a format database for stored format information of the provider; and a module configured to use the format information to convert the portion of the received request into the provisioning request (proprietary format; col.15, lines 33-35; translate content of transactions; col.15, lines 7-11).

As to claim 34, Shavit discloses the computer program product of claim 32, wherein the provisioning module includes a storing module configured to store information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

Art Unit: 2761

As to claim 35, Shavit discloses the computer program product of claim 32, wherein provisioning module includes a module configured to determine a means for providing the provisioning request to the provider (choice available between on-line and manual transaction; col.15, lines 45-60).

As to claim 36, Shavit discloses the computer program product of claim 32, wherein the provisioning module includes a module configured to electronically transmit the provisioning request to the provider (computer communication to distributor; col.14, line 64 - col.15, line 17).

Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 7. Claims 7-12, 22-27, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,799,156 to *Shavit et al.*

Page 13

Application/Control Number: 09/002,276

Art Unit: 2761

As to claim 7, Shavit discloses a method for processing requests for products (processing of business transactions; col.1, lines 1-12); receiving a request identifying a customer (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60); converting portions of the received request into provisioning requests (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and providing the provisioning request to the provider (transmitting order to distributor via authorization inquiry; col. 14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17). However, Shavit does not explicitly disclose a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. Shavit does disclose use of a code name for selected services (col. 10, line 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the code name taught by Shavit as a representation of a plurality of providers such that the request includes a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. This is obvious because the language of Shavit at col. 10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected service and thus meets the limitation of the Applicant's claim recitation directed to a bundle code and use thereof.

Art Unit: 2761

As to claim 8, Shavit discloses the method of claim 7, wherein the converting step includes the substep of deciphering the bundle code to identify the plurality of providers for the selected products (col.10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

As to claim 9, Shavit discloses the method of claim 7, wherein the step of providing the provisioning request to the provider includes the substep of storing information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

As to claim 10, Shavit discloses the method of claim 7, wherein the step of providing the provisioning requests to the providers includes the substep of determining a means for providing each of the provisioning requests to the providers (choice available between on-line and manual transaction; col.15, lines 45-60).

Art Unit: 2761

As to claim 11, Shavit discloses the method of claim 10, wherein the step of providing the provisioning requests to the providers includes the substep of electronically transmitting or physically delivering the provisioning requests to the providers based on the determination (computer communication to distributor; col.14, line 64 - col.15, line 17; manual intercept; col.15, lines 48-51).

As to claim 12, Shavit discloses the method of claim 8, wherein the deciphering step includes the substep of selecting product codes corresponding to the received bundle code from a stored table (searching a catalog by using multiple keys suggests use of product codes (col. 15, lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code identifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that the deciphering step includes the substep of selecting product codes corresponding to the received bundle code from a stored table. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

Art Unit: 2761

As to claim 22, Shavit discloses a billing controller for processing requests for products (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48) comprising: a receiver configured to receive identifying a customer (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFO; col. 10, lines 1-30; col. 12, lines 54-60); a converter configured to convert portions of the received request into provisioning requests (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and a component configured to provide the provisioning request to the provider (transmitting order to distributor via authorization inquiry; col. 14, lines 1-4; computer communication to distributor; col. 14, line 64 - col. 15, line 17). However, Shavit does not explicitly disclose a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. Shavit does disclose use of a code name for selected services (col. 10, line 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the code name taught by Shavit as a representation of a plurality of providers such that the request includes a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. This is obvious because the language of *Shavit* at col.10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected

Art Unit: 2761

service and thus meets the limitation of the Applicant's claim recitation directed to a *bundle code* and use thereof.

As to claim 23, Shavit discloses the billing controller of claim 22, wherein the converter includes a decoder configured to decode the bundle code to identify the plurality of providers for the selected products (col.10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

As to claim 24, Shavit discloses the billing controller of claim 22, wherein the component configured to provide the provisioning request to the provider includes storage configured to store information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

As to claim 25, Shavit discloses the billing controller of claim 22, wherein the component configured to provide the provisioning requests to the providers includes a component configured to determine a means for providing each of the provisioning requests to the providers (choice available between on-line and manual transaction; col. 15, lines 45-60).

Art Unit: 2761

As to claim 26, Shavit discloses the billing controller of claim 22, wherein the component configured to provide the provisioning requests to the providers includes a transmitter configured to electronically transmit the provisioning requests to the providers (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 27, Shavit discloses the billing controller of claim 23, wherein the decoder includes means for selecting product codes corresponding to the received bundle code from a stored table (searching a catalog by using multiple keys suggests use of product codes (col.15, lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code indentifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that the decoder includes means for selecting product codes corresponding to the received bundle code from a stored table. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

Art Unit: 2761

As to claim 37, Shavit discloses a computer program product comprising a computer usable medium having computable readable code embodied therein for processing requests for products (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48), the computer usable medium comprising: a receiving module configured to receive identifying a customer (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60); a converting module configured to convert portions of the received request into provisioning requests (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and a provisioning module configured to provide the provisioning request to the providers (transmitting order to distributor via authorization inquiry; col. 14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17). However, Shavit does not explicitly disclose a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. Shavit does disclose use of a code name for selected services (col. 10, line 62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the code name taught by Shavit as a representation of a plurality of providers such that the request includes a bundle code indicating a plurality of providers for selected products; and converting portions of the received request into provisioning requests based on the code. This is obvious because the language of Shavit at col. 10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of

Application/Control Number: 09/002,276

Page 20

Art Unit: 2761

service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected service and thus meets the limitation of the Applicant's claim recitation directed to a *bundle code* and use thereof.

As to claim 38, Shavit discloses the computer program product of claim 37, wherein the converting module includes a module configured to decipher the bundle code to identify the plurality of providers for the selected products (col.10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

As to claim 39, Shavit discloses the computer program product of claim 37, wherein the provisioning module includes a module configured to store information from the received request as a customer record (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

As to claim 40, Shavit discloses the computer program product of claim 37, wherein the provisioning module includes a module configured to determine a means for providing each of the provisioning requests to the providers (choice available between on-line and manual transaction; col.15, lines 45-60).

Art Unit: 2761

As to claim 41, Shavit discloses the computer program product of claim 37, wherein the provisioning module includes a module configured to electronically transmit the provisioning requests to the providers based on the determination (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to claim 42, Shavit discloses the computer program product of claim 38, wherein the deciphering module includes a module configured to select product codes corresponding to the received bundle code from a stored table (searching a catalog by using multiple keys suggests use of product codes (col.15, lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code indentifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that the deciphering module includes a module configured to select product codes corresponding to the received bundle code from a stored table. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

Application/Control Number: 09/002,276

Art Unit: 2761

- 8. Any inquiry concerning this communication from the Examiner should be directed to Will McCarty whose telephone number is (703) 305-0625.
- 9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

STEPHEN R. TKACS PRIMARY EXAMINER

Will McCarty January 29, 2000

Windows